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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/721,027	11/21/2000	Arne D. Thormodsen	10004352-1	2390

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12/23/2005

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EXAMINER

HUYNH, CONG LAC T

ART UNIT	PAPER NUMBER
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2178

DATE MAILED: 12/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/721,027

Applicant(s)

THORMODSEN ET AL.

Examiner

Cong-Lac Huynh

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 October 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3,5-8,10-13 and 15-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-3,5-8,10-13 and 15-17 is/are allowed.
- 6) ☒ Claim(s) 18-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is responsive to communications: amendment filed 10/5/05 to the application filed on 21/21/00.
2. Claims 4, 9, 14 are canceled.
3. Claims 1-3, 5-8, 10-13, 15-20 are pending in the case. Claims 1, 7, 13, 18 are independent claims.
4. The rejection of claim 14 under 35 USC 112, first paragraph, has been withdrawn in view of Applicants' explanation.
5. The rejections of claims 18-20 under 101 issue remain since Applicants' arguments are not persuasive.

Claim Rejections - 35 USC § 101

6. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

7. Claims 18-20 remain rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 18-20 are directed to a picture book template, which is merely non-functional descriptive material, and thus non-statutory.

Response to Arguments

8. Applicants' arguments filed on 10/5/05 have been considered but are not persuasive.

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Applicants argue that claims 18-20 are statutory subject matter according to Flood v. Coe (Remarks, page 8).

Examiner respectfully disagrees.

Flood is directed to a physical printed page of a price ticket with perforated lines.

Independent claim 18 is directed to an electronic book template, not a physical book template with a requirement of perforated lines as in the case law. Thus, the claims are not related to *Flood*. The book template, thus, is not a printed matter on a substrate or paper as in *Flood*. The fact that Applicants considered the claimed book template as related to the physical price ticket with perforated lines in the *In Flood v. Coe* is not proper. The book template of the invention is merely an arrangement of data such as identifier lines to define pages in the book, an instruction region including assembly instructions, and the graphical depiction with identifier lines to aid in the assembly of the picture book *without any functions related to the data*. The book template, thus, is merely a non-functional descriptive material. The 101 rejection, thus, remains.

Applicants argue that Warmus does not disclose associating a set of assembly instructions with the digital picture book template by positioning a graphical depiction of an assembly of a picture book from the picture book cutout into a digital picture book template, wherein the identifier lines are additionally depicted in the graphical depiction corresponding to the identifier lines of the picture book cutout to aid an individual in the assembly of the picture book (Remarks, page 13).

Examiner agrees.

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Claims 1, 7, and 13, which include said limitations and all of their dependent claims are allowed.

Allowable Subject Matter

9. Claims 1-3, 5-8, 10, 11-13, 15-17 are allowed.

10. The following is a statement of reasons for the indication of allowable subject matter: the book templates with identifier lines to be folded and trimmed to assembly books of different book versions are disclosed in Warmus (figures 6a-b, 7a-b, 8a-b, col 7, line 1 to col 8, line 37). However, positioning a graphical depiction of an assembly of a picture book from a picture book cutout itself into the digital picture book template with identifier lines as depicted in the graphical depiction corresponding to the identifier lines of the book cutout to assembly the picture book are not disclosed or would not have been obvious in Warmus as well as in the prior art of record.

Conclusion

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

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extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Schwab (US Pat No. 6,229,502, filed 11/3/98).

Yokomizo et al. (US Pat No. 6,522,418, 2/18/03, filed 5/12/98).

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cong-Lac Huynh whose telephone number is 571-272-4125. The examiner can normally be reached on Mon-Fri (8:30-6:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Hong can be reached on 571-272-4124. The fax phone number for the organization where this application or proceeding is assigned is 571-273-4125.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Cong-Lac Huynh
Primary Examiner
Art Unit 2178
12/19/05